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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,101	04/16/2007	Albrecht Weiss	C 2816 PCT/US	2593
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FOX ROTHSCHILD LLP 2000 MARKET STREET PHILADELPHIA, PA 19103			EXAMINER HANLEY, SUSAN MARIE	
			ART UNIT 1651	PAPER NUMBER
			NOTIFICATION DATE 06/18/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocket@foxrothschild.com

Office Action Summary

Application No.

10/595,101

Applicant(s)

WEISS ET AL.

Examiner

SUSAN HANLEY

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 20-44 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 20-40, drawn to an emulsion.

Group II, claim(s) 41-44, drawn to a method for the enzyme-catalyzed esterification, transesterification or hydrolysis of fatty acid alkyl esters and/or triglycerides in an o/w emulsion.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The special technical feature of Group I is an emulsion composition comprising water, an emulsifier and oil phase that is produced by phase inversion temperature process and has a droplet size of 50 to 400 nm.

The special technical feature of the enzyme-catalyzed esterification, transesterification or hydrolysis of fatty acid alkyl esters and/or triglycerides in an o/w emulsion which comprises bringing an enzyme into contact with a substrate so that catalysis can occur to produce a fatty acid and and/or a triglyceride (transesterification) or a hydrolysis product of a triglyceride.

Groups I and II lack a corresponding special technical feature because the special technical feature of Group I is an emulsion composition comprising water, an emulsifier and oil phase that is produced by phase inversion temperature process and has a droplet size of 50 to 400 nm and it lacks the process steps and the product yielded by the method of Group II.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Specie election Ia:

Ia. If Group I is elected, Applicant is required to elect if the emulsion comprises

IA. an oily phase that is fatty alkyl esters and triglycerides; OR

IB. an interfacially active enzyme that is a hydrolase and/or an acyl transferase.

The claims are deemed to correspond to the species listed above in the following manner:

Claims 21 and 22 correspond to specie IA. Claims 34-37 correspond to specie IB.

The following claim(s) are generic: claims 1, 23-33 and 38-40..

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: fatty acid alkyl esters and triglycerides are small lipid compounds while an enzyme is a large molecule that has the ability to catalyze chemical reactions.

Specie election Ib:

Ib. If Applicant elects specie IA, Applicant is further required to elect if the oil phase comprises a fatty acid alkyl ester or a triglyceride.

The claims are deemed to correspond to the species listed above in the following manner:

claims 21 and 22 corresponds to the species

The following claim(s) are generic: claims 20, 23-33 and 38-40.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding

special technical features for the following reasons: triglycerides and fatty acid alkyl esters are molecules with distinct chemical structures that have different chemical or physical properties.

Specie election Ic:

Ic. If Applicant elects specie IB, Applicant is further required to choose the enzyme content from a specific enzyme type or types as in claim 35. Applicant is required to make the specie elections with the caution that the elected specie must be a specific compound disclosed per se or that it may be subject to a New Matter rejection.

The claims are deemed to correspond to the species listed above in the following manner:

Claims 35 and 36 correspond to the species.

The following claim(s) are generic: Claims 34 and 37 are reasonably deemed generic and are not a specie per se.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The enzymes catalyze different reactions and do so by different reaction mechanisms.

Specie election Id:

Id. If Applicant elects lipases and/or lipases/acyl transferase from the specie election of Ic, Applicant is further required to elect the specie of microorganisms from which the enzyme(s) originate.

The claims are deemed to correspond to the species listed above in the following manner:

Claims 36 corresponds to the species.

The following claim(s) are generic: Claims 34 and 37 are reasonably deemed generic and are not a specie per se.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: the species of microorganisms lack the same biochemical characteristics.

Specie election Ie

Ie: If Applicant elects Group I, Applicant is required to elect if the reaction is an esterification, a transesterification or hydrolysis reaction.

The claims are deemed to correspond to the species listed above in the following manner:

Claims 38 corresponds to the species.

The following claim(s) are generic: Claims 1 and 23-33 are reasonably deemed generic.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: the reactions required different enzymes that catalyze the specific reactions.

IF Group II is elected, Applicant is required to elect if the reaction is an esterification, a transesterification or hydrolysis reaction.

The claims are deemed to correspond to the species listed above in the following manner:

Claims 41 corresponds to the species.

The following claim(s) are generic: Claims 41-44 are reasonably deemed generic.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: the reactions required different enzymes that catalyze the specific reactions.

IF Group II is elected, Applicant is also required to elect if the substrate is fatty acid alkyl esters, triglycerides or both.

Claims 41 corresponds to the species.

The following claim(s) are generic: Claims 41-44 are reasonably deemed generic.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: because the compounds have different chemical structures and therefore, distinct chemical and physical properties. Each individual specie lacks the special technical feature of the mixture because it lacks one of the other components.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUSAN HANLEY whose telephone number is (571)272-2508. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sandra Saucier/
Primary Examiner, Art Unit 1651

/Susan Hanley/
Examiner, Art Unit 1651